

### REMARKS

Claims 1-5 are pending with claim 1 being independent. No claims have been amended.

Claims 1-4 have been rejected under 35 U.S.C. § 103(a) as being obvious over Lee (U.S. Pat. No. 6,272,961). For at least the following reasons, Applicants respectfully request withdrawal of this rejection.

Claim 1 recites, among other things, "a switch electrically connected to the motor assembly and disposed on the support assembly so that, when the motor assembly is pivoted about the pivot axis, the switch remains stationary." As acknowledged on pages 2-3 of the Office Action, Lee fails to describe at least this feature of claim 1. Rather, Lee describes a switch located on controlling head 45 that moves with motor 42.

The Office Action asserts that it would have been obvious "to provide the switch [of Lee] in an alternative location since it has been held the shifting of parts to different positions is a known variable." Office Action at page 3 (citing In re Japiske, 86 U.S.P.Q. 70 (C.C.P.A. 1960)). However, "[t]he mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." M.P.E.P. § 2144.04(IV)(C) (quoting Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984)). Applicants respectfully submit that Lee fails to provide any motivation or suggestion for making the proposed modification to the position of the switch of Lee. To the contrary, Lee teaches the switch being located on the controlling head 45 to control the electrical controlling means, including the circuit control and fuse, which are used to control the motor 41. Lee at col. 4, lines 17-23. Absent the use of impermissible hindsight, there is no suggestion or motivation to move the location of the switch of Lee.

In addition, having the switch remain stationary, as recited in claim 1, provides significant advantages over the moveable switch shown in Lee. For example, the stationary switch allows the user of the tile saw to know the location of the switch at all times during

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operation of the device. This provides a safety feature when the user must quickly shut off the device during use.

For at least the foregoing reasons, Lee does not form a prima facie case of obviousness against claim 1. Accordingly, the rejection of claim 1, and its dependent claims 2-4, should be withdrawn.

Claim 5 has been rejected under 35 U.S.C. § 103(a) as being obvious over Lee in view of Klingens (U.S. Pat. No. 2,691,398). Claim 5 depends from claim 1 and is allowable for at least the reasons discussed above with respect to claim 1. Moreover, Klingens does not remedy the deficiencies of Lee discussed above with respect to claim 1. In particular, Klingens does not describe or suggest, nor is it relied upon to show, at least the claimed "switch electrically connected to the motor assembly and disposed on the support assembly so that, when the motor assembly is pivoted about the pivot axis, the switch remains stationary." For at least these reasons, claim 5 is patentable over Lee and Klingens.

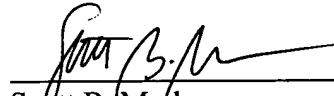
Applicants do not acquiesce to the characterizations of the art. For brevity and to advance prosecution, however, Applicants have not addressed all characterizations of the art, but reserve the right to do so in further prosecution of this or a subsequent application.

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Respectfully submitted,

Date: \_\_\_\_\_

12/14/2005



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